

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-22 are presently active; Claims 1, 8, and 16 having been amended by way of the present amendment. No new matter was added.

In the outstanding Office Action, Claims 1-5 and 8-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Fotland (U.S. Pat. Publ. No. 2001/0048529). Claims 6 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fotland in view of Whiting et al (U.S. Pat. No. 6,618,170). Claims 7 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fotland in view of Chiang et al (U.S. Pat. No. 5,535,021).

Claims 1, 8, and 16 have been amended to clarify that the present invention provides stored image data of the reference color patches at a time of software initialization of the image reading apparatus and that the present invention displays for contrast a first image based on processed image data of the reference color patches after a predetermined plurality of images have been scanned since the software initialization and a second image based on the reference image data stored in the storage unit containing the stored image data of the reference color patches taken at the time of software initialization. These features are shown in Applicant's Figure 8.

Regarding Fotland, as noted in the Office Action, Fotland disclose in numbered paragraph [0026] that "if variable images are being processed, a test pattern must be run to provide a reference file and periodic test patterns also run to provide a sample real-time image." Fotland also disclose in numbered paragraph [0029] that four color step tablet strips are employed as test patterns. Nevertheless, the running of the test patterns in Fotland is not disclosed as being based on a predetermined plurality of images having been scanned since the software initialization. Rather, in Fotland, the use of test patterns occurs periodically only

when variable images are being processed, and as such has no predetermined relationship with the time or the number of images scanned since software initialization.

M.P.E.P. § 2131 requires for anticipation that each and every feature of the claimed invention must be shown and requires for anticipation that the identical invention must be shown in as complete detail as is contained in the claim.

With no disclosure or suggestion in Fotland for test patterns being scanned after a predetermined plurality of images have been scanned since the software initialization, independent Claims 1, 8, and 16 (and the claims dependent therefrom) are believed to patentably define over Fotland.

Independent Claim 9 defines features similar to the other independent claims but further defines the display for contrast of a first image obtained by reading the reference color patches in *an initial state at the time of manufacture of the image reading apparatus* and a second image based on the reference image data stored in the storing step containing the stored image data of the reference color patches. A feature similar but different from the other independent claims.

Claim 9 was rejected in the final Office Action for the same reasons as previously presented Claim 8. Yet, Claim 9 and previously presented Claim 8 did not have the same features. As noted above, Claim 9 defines bases the comparison display on an image of the reference color patches at *an initial state at the time of manufacture of the image reading apparatus*. This feature was not addressed in the final Office Action, and is believed not disclosed or suggested by Fotland.

Given this distinction, it is respectfully submitted that independent Claim 9 and the claims dependent therefrom patentably define over Fotland.

This amendment is submitted in accordance with 37 C.F.R. §1.116 which after final rejection permits entering of amendments canceling claims, complying with any requirement

of form expressly set forth in a previous Office Action, presenting rejected claims in better form for consideration on appeal, or presenting amendments touching on the merits upon a showing of good and sufficient reasons why the amendment is necessary and was not presented earlier. The present amendment addresses an issue previously discussed with the examiner in consideration of an examiner's amendment, thereby placing the present claims in a condition for allowance. No new matter has been added, and this amendment does not raise new issues requiring further consideration and/or search. Furthermore, the present response points out that the features of previously presented Claim 9 were not addressed in the final Office Action. M.P.E.P. §706.07 indicates that:

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

Under these circumstances (especially where the above-noted features of Claim 9 have not been fully addressed in the final Office Action), it is therefore respectfully requested that the present amendment be entered under 37 C.F.R. §1.116.

Application No. 10/086,897
Reply to Office Action of November 29, 2006

Consequently, in view of the present amendment and in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)
GJM:RAR:clh



James J. Kulbaski
Attorney of Record
Registration No. 34,648
Ronald A. Rudder, Ph.D.
Registration No. 45,618

I:\ATTY\RAR\AMENDMENTS (2006)\220287US\RESPONSE TO OA_11292006.DOC